

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Ralph D'Agosta
Application No. 10/606,414	Filing Date: June 26, 2003
Title of Application:	Portable Heated Water Dispensing Device
Confirmation No. 5674	Art Unit: 2836

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**Reply Brief Under 37 CFR §41.41**

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R.R. §41.41 as follows.

**Reply to Examiner's Answer**

As explained in the background of the present application, the Applicant's invention seeks to provide "a portable device that provides heated water out-of-doors, stores the heated water for later use, receives cold water for heating and dispenses heated water through standard hose connections, and is compatible with the environment." (Spec. Par. [0009]). In furtherance of this objective, Applicant claims a portable water heating system with a housing that is "portable to store and transport water received therein;" a water inlet and a first hose nipple for connecting to a water source; a heating element and an adjustable thermostat that controls the heating element; a lining that protects the housing from corrosion; and a water outlet and second hose nipple for distributing heated water. (See e.g. Claim 1).

**The Combination of the Cited References Does not Result in the Claimed Invention as a Whole.**

The Examiner's cited references, Rodriguez et al. (U.S. 2,861,170) and Alston et al. (U.S. 4,947,025), do not satisfy the requirements of a portable water heating system that stores (or holds), transports and distributes heated water and that incorporates an adjustable thermostatic control to control a heating element.

The Examiner interprets Rodriguez et al. as disclosing a housing that is "portable to store and transport water received therein" and references column 1, lines 19-39 as satisfying this limitation. However, this portion of Rodriguez et al. only discusses the

benefit that the disclosed water-heating attachment for cold water pipes is itself portable. Rodriguez et al. does not disclose nor fairly suggest that the water-heating attachment is “portable to store and transport water” and distributes heated water. In fact, the description of how the water-heating attachment operates confirms that it is incapable of meeting the Applicant’s objective of transporting and distributing heated water. Rodriguez et al. explicitly teaches that in order for the water-heating attachment to operate, the unit must “heat up for ten minutes before drawing any water” and then cold water is introduced in to the tank for heating. (Rodriguez, col. 4, l. 3-15). Thus, Rodriguez et al. does not disclose a portable water heating system that stores, transports and distributes heated water because it must be connected to a cold water pipe in order to operate.

As noted in Applicant’s original Appeal Brief, Alston et al. explicitly teaches a device that does not satisfy these requirements. (Alston, col. 1, l. 57-59).

Simply put, both references explicitly teach water heaters that are attached to fixed cold water pipes and only operate when attached to these cold water pipes. Neither reference teaches a portable water heating system that stores, transports and distributes heated water. As a result, any combination of Rodriguez et al. with Alston et al. would not satisfy the requirements of a portable water heating system with a housing that is “portable to store and transport water received therein” and that dispenses heated water.

The Examiner repeatedly refers to the use of the term “adapted to” in the claim and concludes that this does not place “a positive limitation upon an element.” (See e.g. Page 8). However the recited language “adapted to be portable to store and transport water received therein” is a structural limitation on the claim and material to patentability. Further, the scope of the claimed invention cannot be read in isolation of other claimed elements, including the requirement of a portable water heating system that distributes heated water. Thus, the entire scope of the claim requires a portable water heating system that stores, transports and distributes heated water. When considering the patentability of the claims as a whole, these limitations must be taken in to account.

**The Cited References Teach Away the Claimed Invention as a Whole**

Not only does the combination of these references fail to result in claimed invention, but both Rodriguez et al. and Alston et al. teach away Applicant's claimed device as a whole. *In re ICON Health and Fitness Inc.*, 83 U.S.P.Q.2d 1746 (Fed. Cir. 2007) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”). In order to arrive at the entirety of the claims at issue, the Examiner ignores the explicit teachings of both references that lead one skilled in the art away from Applicant's invention. The Examiner has simply picked and chosen different pieces of different references in order to piece together the claimed invention—using the Applicant's disclosure

as a roadmap—which is inappropriate. As the Court of Appeals for the Federal Circuit has explained:

[I]n making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features... The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components.

*Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 75 U.S.P.Q.2d 1051, 1054 (Fed. Cir. 2005) (Fed. Cir. 2005) (citations omitted) (emphasis added). *See also KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1742 (2007) ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.").

Both references teach away the claimed invention as a whole because both references explicitly teach water heaters that are attached to fixed cold water pipes and only operate when attached to these cold water pipes. By teaching devices that only dispense heated water when attached to cold water pipes, both references naturally lead one skilled in the art away from a portable water heating system that stores, transports and distributes heated water.

Further, as noted in Applicant's original Appeal Brief, Rodriguez teaches away the Examiner's proposed combination because Rodriguez teaches a device that con-

trois water temperature with a manually operated valve and simplifies the electrical control of the water heater only incorporating a high temperature cut off. (Rodriguez, col. 1, l. 19-29). Rodriguez et al. explicitly teaches that these are important features of the disclosed water heater and applying the Examiner's suggested combination would be contrary to these teachings.

Similarly, as detailed in Applicant's original brief, the Examiner's proposed combination would be contrary to the explicit teachings of Alston et al., including the teaching that the water heater does not store water enabling the device to be light weight. The Examiner states that it is not necessary to consider all of the teachings of Alston et al., in fact stating that these teachings "have no probative value whatsoever, since the teaching of tankless and lightweight were not relied upon[.]" (Page 11). The Examiner simply disregards the Alston et al.'s teaching that the rheostat 44 and heating element wound about a tube are used in conjunction with a water heater that does not store water. (Alston, col. 1, l. 57-59; col. 2, l. 12-14, l. 30-32). The Examiner also disregards Alston et al.'s teaching that the rheostat 44 is used to control a heating element that surrounds water tubes and does not address how these elements could be incorporated in the Rodriguez et al. device. (Alston, col. 2, l. 39-56). Since the Examiner must consider the patentability of each claim as a whole, the Examiner cannot disregard the entire teaching of Alston et al., including the portions of the reference that lead one skilled in the art away from the claimed invention.

Further, it should be noted that the Examiner does not limit its reliance on Alston et al. to the rheostat, but also relies on the portability of Alston et al. to invalidate the incorporation of wheels (claims 4, 14) and handles (claims 5, 6, 15, 16). In light of the Examiner's purported limited application of Alston et al. and apparent recognition that Alston et al. teaches away a portable water heater that transports and dispenses heated water, the Examiner appears to concede that claims 4, 5, 6, 14, 15, and 16 are patentable over the references of record.

Still further, in order to conclude that the claimed invention is obvious the Examiner reasons that "one of ordinary skill would have looked to any reference pertaining to water heating for adjustable temperature control[.]" (Page 10). Thus, the Examiner is concluding that one skilled in the art would incorporate the rheostat from Alston et al. irrespective of its teachings that would lead one skilled in the art away from arriving at Applicant's claimed invention. This is the type of hindsight bias that the Supreme Court and the Federal Circuit have warned against.

#### **An Adjustable Thermostatic Control**

Applicant would also like to note that the Examiner briefly asserts that the high temperature shut-off disclosed in Rodriguez et al. is an adjustable thermostatic control. Rodriguez discloses a thermostat which acts as a safety device by opening the circuit of the heating coil when the temperature of the valve chamber rises to a predetermined point. (Rodriguez, col. 3, l. 63-71.) The Examiner appears to be attempting to charac-

terize this pre-set thermostat as somehow being an adjustable thermostatic control. Applicant acknowledges that, during examination, pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). However, this basic precept of patent examination does not mean that examiners are free to stretch the meaning of claim terms as far as they desire, and without limitation, in order to cover the teachings of the prior art. Rather, an examiner's interpretation of claim terms must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Here, Applicant respectfully submits that the term "adjustable thermostat" is a term that would be familiar to a person having ordinary skill in the art, and that such a person having ordinary skill in the art would understand the term to mean a thermostat that is adjustable by a user so that at least two (and typically many) set points can be selected by a user. Applicant further respectfully submits that a person having ordinary skill in the art would not understand a thermostat having a (i.e., one) predetermined threshold to be an "adjustable" thermostat. Rather, one skilled in the art would clearly understand the safety thermostat included in the Rodriguez device to be a non-adjustable thermostat, which are non uncommon in safety related applications. The difference in these elements is confirmed by the fact that claim 12 requires "an adjustable thermostatic control" and "a high temperature shutoff element."



For the foregoing reasons, as well as those set forth in Applicant's previously filed Appeal Brief, Appellant respectfully submits that claims 1 and 3-17 are patentable over the cited prior art. Accordingly, it is submitted that the rejection of these claims should be reversed.

Respectfully submitted,

March 10, 2008

/Wesley W. Whitmyer/  
Wesley W. Whitmyer, Jr., Registration No. 33,558  
Christopher H. Strate, Registration No. 57,376  
Attorneys for Applicant  
ST.ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619  
Tel. 203 324-6155